

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Curt Thies
Serial No. : 10/769,210
Filed : January 30, 2004
Title : BEADING

Art Unit : 1796
Examiner : Kelechi C. Egwim
Conf. No. : 7576

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

I. CLAIMS 3-14 PARTICULARLY POINT OUT AND DISTINCTLY CLAIM SUBJECT MATTER WHICH APPLICANT REGARDS AS THE INVENTION.

The Examiner's Answer states:

Claims 3-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 4, from at least one of which claims 5-10 depend, provide for methods of making the beads of claim 1, but, since the claims do not set forth any steps involved in the methods/processes, it is unclear what specific methods/processes applicant is intending to encompass. A claim is indefinite where it merely recites a process without any active, positive steps delimiting the process.

Also, claims 11-14 provide for the use of the beads of claim 1, but, since the claims do not actually set forth any steps involved in the methods/processes, it is unclear what method/process steps applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

P. 4.

Claims 3 and 4 do positively recite methods using terms clearly defined in the specification. Appeal Brief pp. 3-4. It is settled that an applicant may define in the specification terms used in the claims. *Vitronics Corp. v. Conceptronic, Inc.*, 39 U.S.P.Q. 2d 1573, 1576 (Fed. Cir. 1995). "It is well settled that in interpreting an asserted claim, the court should look first to the intrinsic evidence of record, i.e., the patent itself, the claims, the specification and, if in evidence, the prosecution history. See *Markman*, 52 F.3d at 979, 34 USPQ2d at 1329. Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language" . That is what Appellant has done here.

II. CLAIMS 3-14 DEFINE A PROCESS WITHIN 35 U.S.C. §101.

The Examiner's Answer states:

Claims 3-14 are rejected under 35 U.S.C. 101 because the claimed recitations of use/process in these claims, without setting forth any active steps involved in the processes, result in improper definitions of a process in the claims, i.e., results in claims which are not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131,149 USPQ 475 (D.D.C. 1966). Claims 5-10 depend from process claims 3 or 4. Pp. 4-5.

* * *

Regarding the rejection of claims 3-14 under 35 U.S.C. 101:

Appellant does not provide any argument against these statutory rejections. As such, it is summarily requested that these rejections be affirmed as stated above. P.7.

The Appeal Brief did dispute the §101 rejection. The Appeal Brief said:

Claims 3 and 4 do set forth processes and are interpreted in the light of the specification as would be interpreted by a person of ordinary skill in the art.

The pertinence of the specification to claim construction is reinforced by the manner in which a patent is issued. The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). *Phillips v. AWH Corp.*, 76 U.S.P.Q. 1321, 1329 (Fed. Cir. 2005) (en banc).

The specification gives five examples of the water-in-oil emulsion process on pages 5-7 and the droplet extrusion method on page 5 and pages 8-9.

Claims 11-14 positively recite applications 1-4 set forth in detail on pages 9 and 10 of the specification. Pp. 3-4.

The cases on which the Examiner relies are not in point. In *Ex parte Dunki*, 153 U.S.P.Q. 678 (BPA&I 1967) after reversing the final rejection of claims 1-11 upon inserting the word "frictional", the Board ruled that claim 12 to "the use of a high carbon austenitic iron alloy

having a proportion of free carbon as a vehicle brake part subject to stress by sliding friction" was properly rejected as an improper definition of a process in that the word "use" does not describe a process. That case followed *Clinical Prod. Ltd. v. Brenner*, 149 U.S.P.Q. 475 (D.D.C. 1966) which ruled that claim 41 calling for "the use as sustained release therapeutic agent in the body of the ephedrine adsorbed upon polystyrene sulphonic acid" did not come within any of the statutory classes of patentable subject matter set forth in 35 U.S.C. §101 because a new use of a composition of matter known to be old *per se* should be set forth in the form of a process or method claim in order to be patentable. Manifestly, claims 3, 4, 13 and 14 do positively recite methods that are processes within the meaning of 35 U.S.C. §101 and meet at least the test approved in *Kappos v. Bilsky*, 561 U.S. __ (2010) that involve transformation of an article into a different state or thing and do not involve a new use of a composition of matter known to be old *per se*. "In the absence of the article in the prior art we find no basis for the conclusion that the manipulative steps of assembling the nonexistent article would be obvious." *Ex parte Rubin*, 127 U.S.P.Q. 286, 287 (Bd. of Appeals 1959).

III. CLAIMS 1-14 ARE NOT ANTICIPATED BY JEDERSTROM, AND THE DIFFERENCES BETWEEN CLAIMS 1-14 AND JEDERSTROM ARE SUCH THAT THE SUBJECT MATTER AS A WHOLE WOULD NOT HAVE BEEN OBVIOUS TO A PERSON OF ORDINARY SKILL IN THE ART AT THE TIME THE INVENTION WAS MADE

The Examiner's Answer states:

Regarding the rejection of Claims 1-14 under 102/103 over Jederstrom et al:
Applicant argues that placing the beads in an aqueous solution of low molecular weight poly-lower alkylene glycol does not produce dry beads. However, it is the beads themselves that anticipate the present claims, not the aqueous solution containing the beads. The beads themselves are described as dry polymer bead particles comprising water-absorbent polysaccharides such as dextran. (In col. 1, lines 10-26 and col. 3, lines 26-42)

In response to applicants arguments, it is noted that GB 1,454,055, incorporated by reference in Jederstrom et al., teach that the disclosed beads, which are polymer beads of dry bead structure incorporating a compound such as dextran, consistent with applicant's classification of a diluent compound (see. page 4, lines 19-28 of present specification), are highly water-soluble characterized by "a high swelling rate when it comes into contact with water or with an aqueous fluid" (see in page 3, lines 91-96 of GB 1,454,055). It is noted that the "water-soluble diluent compound" is not and cannot functional as a diluent in the claimed dry bead products, as the beads are dry and contain no liquid component, dilute or otherwise. Any compound contained therein would itself also be dry as part of the bead.

Regarding diffusion into the beads, as stated above, the prior art not only teaches swelling, but teaches a high swelling rate into the polymer beads. (See in page 3, lines 91-96 of GB 1,454,055, explicitly incorporated by reference in Jederstrom et al.)

While applicant argues that the structure of the chemically cross linked beads disclosed in the reference cannot possibly meet the limitations of the claimed invention, the have provide no data to support such a conclusion. Particularly in view of the teaching in the prior art that said high rate of swelling is achieved for the beads. Pp. 7-8

It appears as if the Examiner has switched the ground of rejection over a single reference to a rejection on a combination of references for the first time.

We thoroughly discussed the rejection on Jederstrom in the appeal brief, Pp. 8-12. The Examiner was respectfully requested to quote verbatim the language in the reference regarded as corresponding to each limitation in the rejected claims, and quote verbatim the language in the reference regarded as suggesting the desirability of modifying what is there disclosed to meet the limitations of each rejected claim. The Examiner did not and cannot comply with this request.

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CONCLUSION

In view of the foregoing authorities and remarks, those in the Appeal Brief and the inability of the prior art to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, the decision of the Examiner finally rejecting the claims which particularly point out and distinctly claim patent eligible subject matter which applicant regards as the invention should be reversed. Should the Board believe a claim or an appeal may be amended to overcome a rejection, the Board is respectfully requested to include an explicit statement of how such a claim may be amended to overcome a rejection and afford Appellant the right to amend in conformity therewith.

Please apply any charges or credits to Deposit Account No. 06-1050, referencing order no. 04015-0005001/AATH1P05.

Respectfully submitted,
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12 July 2010
Date: _____

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